REMARKS

Summary of the Office Action

In the Office Action, claims 1, 5-11, 15-19, 21-24, and 27-29 stand rejected under 35

U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publishing No.

2002/00534090 to *Silva et al.* ("*Silva*") in view of U.S. Patent Application Publishing No.

2002/0165955 to *Johnson et al.*, hereinafter ("*Johnson*").

Claims 3, 13, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over

Silva in view of *Johnson*, as applied to claims 1, 11, and 24 above, and further in view of Mr.

Cluey ("How can I find out how many hyperlinks there are on a paper?" published on September

10, 2000).

Claims 4, 14, 20, and 26 are objected to as being dependent upon the rejected base claim,

but would be allowable if rewritten in independent form including all the features of the base

claim and any intervening claims.

Summary of the Response to the Office Action

Applicant appreciates the Examiner's indication that claims 4, 14, 20, and 26 are directed

to allowable subject matter. Accordingly, claims 1, 3-11, and 13-29 are pending for further

consideration.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 1, 5-11, 15-19, 21-24, and 27-29 stand rejected under 35 U.S.C. § 103(a) as being

unpatentable over *Silva* in view of *Johnson*. Applicant respectfully traverses the rejection for the

following reasons.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under "no obligation to submit evidence of nonobviousness," such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by the Applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations. The Office Action fails to meet at least the third criteria.

Applicant respectfully submits that independent claims 1, 11, and 24 include the features of "[a] system for dynamically translating a Hypertext Markup Language (HTML) document to Voice eXtensible Markup Language (VoiceXML) form . . . ." At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Silva* or *Johnson*.

The Office Action asserts that *Silva* teaches a method of dynamically formatting web pages. However, the opposite is true. *Silva* teaches a method by which a user can create predetermined "web views" – personalized views of web pages containing abbreviated content – for later retrieval by devices having limited bandwidth, such as a PDA etc. *Silva* teaches that the web views are first created by the user before they can be accessed by an electronic device. See at least page 1, paragraph [0009] through page 2, paragraph [0010] of *Silva*. *Silva* is like the

services mentioned in the background section of the present invention (see pages 3 and 4, paragraph [0006]), which list access to websites that have been manually pre-converted into voice-enabled form such as VoiceXML.

Silva does not teach or suggest a system for dynamically translating a HTML document to VoiceXML form at all. There is no dynamic translation mentioned. The mere fact that *Silva* mentions the VoiceXML format for accessing the web (see paragraph [0005]) should not be turned into an argument for asserting the dynamic format of web pages.

The Office Action also asserts that *Johnson* teaches a method in which an HTML document is partitioned into a plurality of text sections and link sections as described on page 2, paragraphs 0028-0029 and page 5, paragraphs 0067-0069. However, *Johnson* fails to teach or suggest at least a method in which an HTML document is *partitioned* into a plurality of text sections and link sections, as claimed. Rather, what *Johnson* discloses at page 2, paragraphs 0028-0029, and page 5, paragraphs 0067-0069 (the sections cited to by the Examiner) is a Web page that *contains* text sections and link sections. This is markedly different from the present invention, which includes a method of *partitioning* an existing HTML document into a plurality of text sections and link sections. Thus, no combination of *Silva* and *Johnson* discloses each and every feature of the pending independent claims. The Free On-Line Dictionary of Computing, mentioned by the Examiner, does not provide the missing disclosure.

As pointed out in M.P.E.P. § 2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art". *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met. Therefore, Applicant respectfully

requests that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Silva* and *Johnson* do not teach or suggest each and every feature of independent claims 1, 11, and 24.

Additionally, Applicant respectfully submits that dependent claims 5-10, 15-19, 21-23, and 27-29 are also allowable insofar as they recite the patentable combinations of features recited in claims 1, 11, and 24, as well as reciting additional features that further distinguish over the applied prior art.

With regard to claims 3, 13, and 25, which stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Silva* in view of *Johnson*, as applied to claims 1, 11, and 24 above, and further in view of a Mr. Cluey article "How can I find out how many hyperlinks there are on a paper?" (published on September 10, 2000), the article does not overcome the above-mentioned deficiencies of either *Silva* or *Johnson*.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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